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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,002	11/16/2001	Margareta Gunilla Bjorksten	005288.00013	7989

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BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application**

09/988,002

**Applicant(s)**

BJORKSTEN ET AL.

**Examiner**

Jonathan Ouellette

**Art Unit**

3629

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 18-28, 35, 45 and 48-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-28, 35, 45 and 48-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The Request filed on 1/22/2004 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/988,002 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Response to Amendment***

2. Claims 16-17, 29-34, 36-44, and 46-47 have been cancelled and Claims 48-62 have been added; therefore Claims 1-15, 18-28, 35, 45, and 48-62 are now pending in application 09/988,002.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-4, 10-15, 18-21, 23-25, 27-28, 35, 45, 48-51, and 57-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over mValue (www.mvalue.com, Screen Print, 3/1/2000-8/15/2000).
5. As per independent Claims 1, 25, 35, and 48, mValue discloses a method (system, mobile device, computer readable medium) for controlling access, use and distribution of

personal data of a user stored in a personal data repository, the method comprising the steps of: receiving input defining personal data comprising a master profile for storage in the personal repository, the master profile corresponding to the user; reaching an agreement, between the user and the second party, regarding release to the second party of the identified service profile; and providing the identified service profile from the personal data repository to the second party according to the agreement (www.mvalue.com, pg.2, pgs.7-8, pgs.23-24).

6. MValue fails to expressly disclose receiving input defining personal data comprising one or more service profiles for storage in the personal repository and receiving user input identifying one of the service profiles stored in the personal data repository as corresponding to a second party.
7. However, mValue does disclose allowing the user to identify and selectively block access to their personal data from companies (pgs.23-24, mPrivacy). MValue also discloses tracking second party (company) information who are interested in obtaining user profile (master profile) data (pgs.7-8).
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving input defining personal data comprising one or more service profiles for storage in the personal repository and receiving user input identifying one of the service profiles stored in the personal data repository as corresponding to a second party, in the system disclosed by mValue, for the advantage of providing a method (system, mobile device, computer readable medium) for controlling access, use and distribution of personal data of a user stored in a personal data repository,

with the ability to increase system/method effectiveness by allowing the user to select companies they wish to interact with (instead of just allowing them to select companies they do not want to interact with).

9. As per Claims 2 and 49, mValue discloses wherein the personal data comprises automatically collected information.
10. As per Claims 3 and 50, mValue discloses wherein the step of reaching the agreement comprises choosing an agreement provided by an independent agreement provider, wherein the independent agreement provider receives compensation based on use of the provided agreement.
11. As per Claims 4 and 51, mValue discloses wherein the personal data comprises information entered by the user.
12. As per Claims 10 and 57, mValue discloses wherein the identified service profile includes information regarding a data and a time that any of the information in the identified service profile was released to the second party and to whom the stored information was released.
13. As per Claims 11 and 58, mValue discloses wherein the service profile includes information pertaining to a description of the agreement between the user and the second party.
14. As per Claims 12 and 59, mValue discloses acting, by a trusted party, as an agent of the user to negotiate use, by the second party, of any of the personal data of the user in return for compensation to the user for the use of any of the personal data.

15. As per Claims 13, 27, and 60, mValue discloses automatically recording a history of actions, by the user, using a user device, as part of the personal data of the user.
16. As per Claims 14, 28, and 61, mValue discloses receiving user input defining a type of action to be automatically recorded.
17. As per Claims 15 and 62, mValue discloses receiving, at a trusted party device connected to a computer network, a first request from a device operated by the user; forming a second request based on the first request, the second request being stripped of information that can associate the user with the second request; sending, from the trusted party device, the second request over a computer network to a second party device; receiving, at the trusted party device, response information in response to the sending of the second request; forming a response based on the response information; and sending the response to the device operated by the user.
18. As per independent Claim 18, mValue discloses a system for providing personal data of a user with access rights being controlled by the user, the system comprising: a user device; a trusted party device, the user device being arranged to communicate with the trusted party device; at least one data storage device storing personal data of the user, said personal data comprising a master profile; a rules enforcer included in the trusted party device to enforce rules by which the personal data of the user can be accessed and used by a second party device (inherent), the rules having been agreed to by the user and a second party associated with the second party device (inherent), wherein: the at least one data storage device is associated with at least one of the user device and the trusted party device (www.mvalue.com, pg.2, pgs.7-8, pgs.23-24).

19. MValue fails to expressly disclose receiving input defining personal data comprising one or more service profiles.
20. However, mValue does disclose allowing the user to identify and selectively block access to their personal data from companies (pgs.23-24, mPrivacy). MValue also discloses tracking second party (company) information who are interested in obtaining user profile (master profile) data (pgs.7-8).
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving input defining personal data comprising one or more service profiles, in the system disclosed by mValue, for the advantage of providing a method (system, mobile device, computer readable medium) for controlling access, use and distribution of personal data of a user stored in a personal data repository, with the ability to increase system/method effectiveness by allowing the user to select companies they wish to interact with (instead of just allowing them to select companies they do not want to interact with).
22. As per Claim 19, mValue discloses a plurality of trusted party devices, each of the trusted party devices being configured to communicate with at least one other of the plurality of trusted party devices, and wherein the at least one storage device is included in at least some of the plurality of trusted party devices and the personal data of the user is distributed among the at least one storage device of at least some of the plurality of trusted party devices.
23. As per Claim 20, mValue discloses wherein the trusted party device further comprises an agreement facilitator to facilitate an agreement between the user and the trusted party.

24. As per Claim 21, mValue discloses wherein the user device further comprises an agreement facilitator to facilitate an agreement between the user and the trusted party.
25. As per Claim 23, mValue discloses wherein the trusted party device further comprises a history recorder to automatically record a history of actions performed by the user device.
26. As per Claim 24, mValue discloses wherein the history recorder includes an action selector by which the user, via the user device, can define the actions to be automatically recorded.
27. As per independent Claim 45, mValue discloses a mobile device for providing personal data of a user with access rights being controlled by the user, the mobile device comprising: a rules enforcer to enforce the rules by which the personal data of the user can be accessed and used by a second party device (inherent), the rules having been agreed to by the user and a second party associated with the second party device (inherent); a data storage device having recorded therein at least some of the personal data of the user; an agreement facilitator to facilitate an agreement between the user and the second party (www.mvalue.com, pg.2, pgs.7-8, pgs.23-24).
28. MValue fails to expressly disclose a history recorder to record a history of actions by the user via the user device, the history recorder including a level selector to select a level of the actions to be recorder' wherein the data storage device is arranged to have recorded therein at least a portion of a service profile including information regarding what portions of the stored personal data of the user can be released to the second party and conditions under which the portions of the service profile can be released to the second party.



29. However, mValue does disclose tracking the transactions between users and companies (pgs.7-8), and mValue further discloses allowing the user to select the price and type of information to provide to companies (pg.2, pgs.7-8, pgs.23-24).

30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a history recorder to record a history of actions by the user via the user device, the history recorder including a level selector to select a level of the actions to be recorder' wherein the data storage device is arranged to have recorded therein at least a portion of a service profile including information regarding what portions of the stored personal data of the user can be released to the second party and conditions under which the portions of the service profile can be released to the second party, in the system disclosed by mValue, for the advantage of providing a method (system, mobile device, computer readable medium) for controlling access, use and distribution of personal data of a user stored in a personal data repository, with the ability to increase system/method effectiveness by tracking system transactions and allowing the user to select transaction types (money/information) with companies.

**31. Claims 5-9, 22, 26, and 52-56 are rejected under 35 U.S.C. 103 as being unpatentable over mValue.**

32. As per Claims 5-7 and 52-54, mValue does not expressly show storing the personal data on a device operated by the user, on a trusted party device, or in a distributed manner among a plurality of trusted party devices.

33. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, device, mobile

device, machine-readable medium) for controlling access, use and distribution of personal data of a user stored in a personal data repository would be performed regardless of where the personal data was stored. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have stored the personal about the user on a device operated by the user, on a trusted party device, or in a distributed manner among a plurality of trusted party devices, because such a storage type does not functionally relate to the steps in the method claimed and because the subjective interpretation of the storage type does not patentably distinguish the claimed invention.

35. As per Claims 8 and 55, mValue does not expressly show wherein the identified service profile comprises music preferences.

36. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, device, mobile device, machine-readable medium) for controlling access, use and distribution of personal data of a user stored in a personal data repository would be performed regardless of type of service profile used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

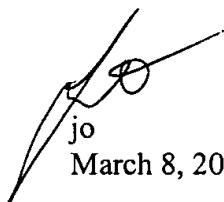
37. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have identified music preferences as an identified service profile, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
38. As per Claims 9, 22, 26, and 56, mValue does not expressly show wherein the second party comprises a financial institution, and wherein the identified service profile comprises financial information.
39. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, device, mobile device, machine-readable medium) for controlling access, use and distribution of personal data of a user stored in a personal data repository would be performed regardless of type of service profile/second party used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have identified financial information as an identified service profile and a financial institution as the second party, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

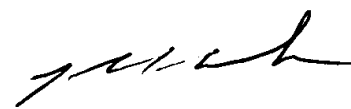
***Response to Arguments***

41. Applicant's arguments with respect to claims 1-15, 18-28, 35, 45, and 48-62 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
43. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
44. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

  
jo  
March 8, 2004

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600